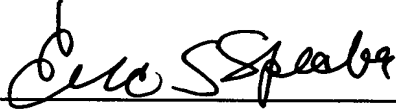




PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		AUST3001CIP	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on		Application Number	Filed
		09/991,702	11/26/01
		First Named Inventor	
Signature		Gino PALUMBO	
Typed or printed name	Eric S. Spector	Art Unit	Examiner
		1742	Sikyin Ip
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 22,495</p> <p> Signature</p> <p>Eric S. Spector Typed or printed name</p> <p>703-683-0500 Telephone number</p> <p>October 5, 2005 Date</p> <p>Bacon & Thomas, PLLC, Customer No. 23364</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of forms are submitted.</p>			



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Gino PALUMBO

Patent Application No. 09/991,702

Filed: November 26, 2001

For: THERMO-MECHANICAL TREATED
LEAD AND LEAD ALLOYS . . .

)
) Group Art Unit: 1742
)
) Examiner: S. Ip
)
) Confirmation No.: 3992
)
) Attny. Dkt. No.: AUST3001/CIP

ARGUMENTS IN FAVOR OF REVERSAL OF REJECTION
AND ALLOWANCE AT PRE-BRIEF CONFERENCE

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

This paper accompanies a PRE-APPEAL BRIEF REQUEST FOR REVIEW
(PTO/SB/33). The arguments herein are in response to the final Office action of July 14, 2005.
A Notice of Appeal is submitted concurrently herewith along with the appropriate fee.

ARGUMENT

There is a sole remaining rejection. Claims 40-52 are rejected under 35 U.S.C. 103 as being unpatentable over Yasuda JP 06-267544. The position in the Office Action is that JP 06-267544 teaches cold working at 120°C or less and recrystallization annealing at 60°C or more and that cold working at up to 120°C would require recrystallization annealing at 120°C or more and that recrystallization annealing at 120°C or more would result in Fsp content greater than 20%.

Applicants contend that the rejection is defective on three bases.

Firstly, the rejection is based on the position that cold working is done below the recrystallization temperature, but this position is unsupported. Support is required. See In re Beasley, Fed. Cir. No. 04-1225, which requires concrete evidence and not what the rejection says is well known. The Office Action asks applicant to agree to what it states is well known. Applicant doesn't have to agree or disagree with this. The point is the rejection is defective. Applicant doesn't have to cure the defect. Moreover, the issue is submitted to be misstated as Yasuda mentions only partial recrystallization is obtained (See (B) hereinafter).

Secondly, the rejection is defective because applicant has shown (declaration submitted on October 18, 2004) that the closest definite prior art (the only Working Example in Yasuda) doesn't meet the at least 20% Fsp limitation of the claims or provide the advantages thereof. Consider that the working example of Yasuda is the only portion of Yasuda relative to the claimed invention, that is not confusing and inconsistent, as indicated with applicant's third position below.

Thirdly, applicants take the position that the rejection is defective because the cold rolling upper temperature limit relied on in the Office Action, as interpreted in the Office

Action, is inconsistent with the rest of Yasuda and therefore cannot be relied on as a basis for a rejection based on obviousness.

The inconsistencies in Yasuda referred about are as follows:

(A) Yasuda requires a paste to be present during heat treating. This means that the heat treating has to be carried out at 66°C or less if Yasuda's pasted grid is not to be destroyed, or else the requirement of paste presence has to be ignored. (See paragraph 5 of the declaration submitted October 18, 2004, and the literature cited therein).

(B) Yasuda requirements or advantages include "mechanical reinforcement" [0014] and increase in mechanical strength [0027]; however, if Yasuda obtains Fsp of at least 20%, ductility increases so mechanical reinforcement and increase in mechanical strength would not be obtained. As outlined in the declaration filed with the response on October 18, 2004 (page 2, #1a), the hardness of Yasuda's only working example was found to increase from 12.2 to 19.7HV verifying the increased "mechanical reinforcement". Yasuda's only working example achieved a very low Fsp count ($F_{sp} < 10\%$) which would be expected based on the increased hardness, contrary to the process of the instant patent application (see claim 44 and examples in the instant application). Moreover, please note that Yasuda admits that he obtains only partial recrystallization; see [0021] and [0025] and also in the CONSTITUTION on the front page.

(C) Yasuda, in its only working example, heat treats the pasted grid to partially recrystallize the grid at 60°C for 48 hours (in line with his statement that he achieves partial recrystallization at 60°C) which is below the 120°C maximum cold rolling temperature and below the 66°C known to be detrimental to the paste (see Declaration filed with the response of October 18, 2004).

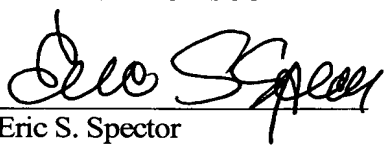
Thus, to obtain the claimed Fsp requirement, one has to change (omit) Yasuda's paste presence requirement during heat treating and not satisfy Yasuda's stated benefits of mechanical

reinforcement and increased mechanical strength. It is submitted there is no motivation in Yasuda for omitting paste presence requirement and not obtaining mechanical strength/reinforcement, because Yasuda does not mention Fsp or indicate how to increase Fsp content or that at least 20% Fsp would provide a benefit. Yasuda, in its paragraph [0027] mentions corrosion resistance but seems to attribute obtaining this to addition of tin and calcium and nowhere attributes corrosion resistance to his partial recrystallization. The only source of informative guidance provided by Yasuda is its working example which has been shown not to provide at least 20% Fsp, while enhancing the hardness from 12.2 to 19.7HV. (See the declaration filed with the response of October 18, 2004). It is submitted that the working example should be governing because of the inconsistencies noted on deviation therefrom. It is submitted that Yasuda is so confusing and non-informative that the rejection can only be based on improper hindsight. Moreover, the need to omit a requirement of Yasuda and not obtain a benefit Yasuda says he obtains, shows the interpretation of the rejection, of Yasuda permitting heat treating of pasted plates at above 120°C, has to be wrong and based on improper hindsight.

Reversal of the rejection and allowance of claims 40-52, is requested.

Respectfully submitted,

BACON & THOMAS PLLC

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B&T Docket No. AUST 3001/CIP

Date: October 5, 2005